

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: M. Masters et al.

Serial No.: 09/944,315


For: Textured Surfaces for
Hearing Instruments

Filed: August 31, 2001

Group: 2643

Examiner: Phylesha L. Dabney

Att'y Dkt.: 2001 P 16281 US

Certificate of Transmission
Pursuant to 37 C.F.R. § 1.8I hereby certify that this paper is being sent this
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Date of Signature

Reply Brief on Appeal

Commissioner for Patents
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Via Facsimile Only

Sir:

This reply brief responds to the examiner's answer mailed August 19, 2004.

Formal Matters

Related Appeals and Interferences

On July 27, 2004, subsequent to the submission of the brief herein on May 4, 2004, an appeal was commenced in related application serial no. 09/944,314. Contrary to the statement in the answer, the brief in this matter correctly stated that there were no related appeals or interferences as of the date it was submitted.

Grouping of Claims

Since the applicants suggested that the Board may rely upon claim 2 or 8 to represent all three groups of the claims (claims 1-7 and 19; claims 8-13; and claims 14-18), an argument per 37 C.F.R. § 192(c)(7) was not made.

Argument

The legal standard applied by the examiner to construe the claims is incomplete. While claims are broadly construed during prosecution, the Examiner's Answer sidesteps the admonition of the Federal Circuit that this interpretation must be "reasonable" and "consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 U.S.P.Q.2d 1664, 1667 (Fed. Cir. 2000). Nowhere is this discussed or considered in the Examiner's Answer.

To reach a construction "consistent with the specification," the specification must be considered -- not for the purpose of reading limitations into the claims but rather to understand the usage of the term. The application states that the "the textured finish has an appearance closer to that of natural skin and therefore the hearing instrument is less noticeable to others, blending in with the visible portions of the ear." Application, page 2, lines 10-13. Absent some gross deformity or disease, skin would not have the appearance of the structural reinforcing ribs (on an otherwise smooth surface) shown in Widmer et al.:

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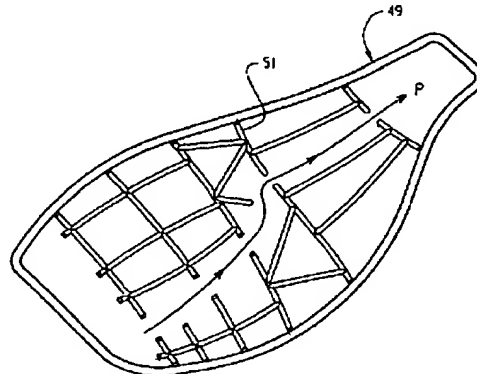


Fig. 18


Additionally, such large and sharp-edged protrusions would lead to discomfort. Cf. applicants' abstract, page 14, lines 1-3 ("[t]he physical fit, comfort, and appearance of a hearing instrument that resides in the ear can be improved by providing the shell of the instrument with a textured finish"). Thus, the assertion that "texture" reads on structure of Widmer et al. is not a "reasonable" conclusion.

Another aspect of this inquiry not treated by the Examiner's Answer is the role of the skilled artisan, since the interpretation of the claims "must be consistent with ... one that those skilled in the art would reach." *In re Cortright*, 165 F.3d 1353, 1358, 49 U.S.P.Q.2d 1464, 1467 (Fed. Cir. 1999). Manufacturers of hearing instruments are quite concerned with the appearance of their products and strive to make them inconspicuous. (See the quote at the top of this page.) The rib pattern depicted in Widmer et al. would only draw attention to the instrument.

When the totality of the application is considered, a reasonable construction of the term "texture" consistent with the specification and one that a person skilled in the art would reach cannot encompass Widmer et al. The applicants respectfully request that the Board reverse the examiner and direct that the application be passed to allowance.

Dated: September 21, 2004

Respectfully submitted,


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